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REMARKS*Status of the Application*

Claims 2-14, 16-25, 27-33, 35-41, and 43 are pending.

The only outstanding rejection against the pending claims is a rejection over co-owned US Serial No. 10/669,422 (" '422 Application") and 10/670,670 (" '670 Application") under 35 USC §101 for double patenting. Applicant traverses, on all grounds set forth below, and respectfully requests reconsideration of the statutory double patenting rejection. Applicant would prefer not to appeal this rejection, but will do so if necessary.

Prima Facie Case of Double Patenting

The Examiner has rejected the pending claims provisionally under statutory double patenting ("same invention" double patenting) without establishing a prima facie case of double patenting, as is required (please see the Office Actions dated January 24, 2006 and July 14, 2006). Neither Office Action provides evidence that specifies the identity of elements of the pending claims and those of either claims 1-39 of the '422 application or of claims 1-22 of the '670 application. See *Ex parte Davis*, 56 USPQ2d 1434 (BPAI 2000)(unpublished). The test recommended by the MPEP for determining whether a double patenting rejection under 35 U.S.C. § 101 is proper is: whether a claim in the application under review could be literally infringed without literally infringing a corresponding claim in the co-pending applications. MPEP 804.II.A. If this literal infringement test is not met, then a statutory or "same invention" double patenting rejection is improper. The burden of establishing a prima facie case of same invention double patenting lies with the Office. Where sufficient evidence to support a prima facie double patenting rejection has not been provided, the rejection is improper. See *Ex parte Davis* at 1437-38. Here, the literal infringement analysis (alternatively stated, whether the claims of the application under review and those of the copending application(s) cannot be literally infringed without infringing each other) has not been performed in this case. On this basis, the rejection should be withdrawn.

Same Inventions

The literal infringement test alluded to above and recited in the MPEP was established by the CCPA in 1970 in the case of *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). This opinion and subsequent practice establish that in the area of double patenting, inventions are either the same, obviously variant, or nonobviously variant. For statutory double patenting to apply, the inventions in question must be identical, that is, the subject matter must be identical. Please see *Vogel* at 164 USPQ 621-22.

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A brief review of the subject matter of the copending claims will establish that the subject matter is not identical. *Vogel* cited above addressed the issue of whether processes for preparing pork products and processes for meat packaging were identical. The second application had a dependent claim relating to processes for preparing beef products. The CCPA held that pork and beef were distinct subject matter in the claims and that the literal infringement test failed with respect to the two applications-at-issue. The Court specifically held, at the passage cited on pages 621-22, that "the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine'" (emphasis in original) because there is a difference in claim breadth that precludes identity of claimed subject matter.

The claims in all three copending applications are directed to compositions of matter. As to the claims presently under review, claim 2 recites a composition comprising an aqueous dispersion of an electrically conductive organic polymer doped with a polymeric acid and a plurality of nanoparticles wherein the organic polymer is selected from a combination of any two or more polyanilines, polythiophenes and polypyrroles. Claim 1 of the '422 application is directed to a composition comprising an aqueous dispersion of an electrically conductive organic polymer and a plurality of nanoparticles. The main independent claim of the '670 application (claim 2) recites a composition comprising an aqueous dispersion of an electrically conductive organic polymer and a plurality of nanoparticles wherein the organic polymer is selected from polyaniline with poly(2-acrylamido-2-methyl-1-propanesulfonic acid) as the counterion, polythiophene and poly(ethylene dioxythiophene) with poly(styrenesulfonic acid) as the counterion, and wherein the nanoparticles are selected from organic nanoparticles, inorganic nanoparticles, and mixtures thereof. It is clear from this overview of the main independent claims of the three copending applications that any one could be literally infringed without literally infringing the others. A similar analysis of dependent claims would lead to the same conclusion.

The remaining independent claims of the application under review recite a buffer layer having compositional properties similar to claim 2 (claim 14 and dependent claims), an organic electronic device comprising a buffer layer relating to compositional properties recited in claims 2 and 14 (claim 25 and dependent claims), and a thin film field effect transistor electrode having compositional properties as set forth in claim 2 (claim 33 and dependent claims).

The other independent claims of the '422 application recite a high resistance buffer layer comprising an electrically conductive polymer and a plurality of nanoparticles (claim 12

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and dependent claims), an OLED comprising a high resistance buffer layer having compositional properties like those recited in claims 1 and 12 (claim 20 and dependent claims), a thin film field effect transistor electrode having compositional properties as recited in claims 1, 12 and 20 (claim 27 and dependent claims), and method claims (claims 36-39).

The '670 application has two additional independent claims directed to a high resistance buffer layer comprising an electrically conductive polymer and a plurality of nanoparticles dispersed therein where the nanoparticles are selected from inorganic nanoparticles, organic nanoparticles, and mixtures thereof.

Clearly, the literal infringement test fails in this instance based on claim analysis. In addition, as stated in note 1, *infra*, and accompanying text, the copending '670 application has been rejected provisionally on obviousness type (non-statutory) double patenting. Logically, then, the infringement test must fail on that basis alone since, if the '670 claims are asserted to be obvious variants of the present claims, they do not present identical subject matter. See *Vogel* in this regard as well. Applicant respectfully requests that the rejection be withdrawn on the foregoing basis.

Double Patenting is the Only Remaining Rejection

Applicant respectfully asserts that the Examiner is not properly following the guidance set forth in the MPEP. This guidance, as outlined above, has a meaningful foundation in appellate and PTO Board decisions. The MPEP is explicit in its directions for situations of this nature, as it provides:

2. Statutory Double Patenting Rejections (35 U.S.C. 101)

... If a "provisional" statutory double patenting rejection is the only rejection remaining in one of the applications (but not both), the examiner should withdraw the rejection in that application and permit that application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application into a double patenting rejection when the application issues as a patent.

MPEP §804.B.2 (emphasis added). Accordingly, the Examiner must allow this case to proceed to issue, as "the only rejection remaining in one of the applications (but not both)" is statutory double patenting.

In addition, withholding allowance of the present claims based on the '422 Application is improper because that application has no outstanding statutory double patenting rejection. Likewise, the rejection based on the '670 Application is improper because that application has

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no outstanding *statutory* double patenting rejection.¹ Thus, since the only rejection remaining in one of the applications (the present case) is statutory double patenting, the Examiner should withdraw the rejection and permit that application to issue as a patent.

Applicant requests that the Examiner follow the directions of the MPEP and allow this case to proceed to issue.

Conclusion

Applicant respectfully submits that the statutory double patenting rejection of all pending claims should be withdrawn pursuant to all three bases relied upon in the Remarks presented above. Applicant further respectfully submits that the pending claims are in condition for allowance, and earnestly solicits a notice of allowance for claims 2-14, 16-25, 27-33, 35-41, and 43.

Should the Examiner have questions about the status of the application or the contents of this paper, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,



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¹ Applicant notes that if the '670 Application was intended to be rejected under statutory double patenting, the course that the Examiner has taken in finally rejecting *both* the '670 Application AND this application is improper - one of them should be allowed. See MPEP §804.B.2 ("If a "provisional" statutory double patenting rejection is the only rejection remaining in both applications, the examiner should withdraw that rejection in the application with the earlier filing date and permit that application to issue as a patent.").